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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,708	02/21/2002	Seo-Young Park	1599-0214P	6239

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EXAMINER

TATE, CHRISTOPHER ROBIN

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/078,708

Applicant(s)

Park et al.

Examiner

Christopher Tate

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rendered vague and indefinite because it lacks one or more essential process steps including a final recovery step of the desired product - e.g., it is unclear as to what is being obtained from the single process step (see, e.g., MPEP 2172.01). Thus, it is unclear as to the definition of the final processed product - e.g., is an extract obtained via steam heating, is a precipitate obtained which is left over from the steaming step, or something else? It is strongly suggested that claim 1 be expanded upon so as to fully and completely define a process of making the disclosed *Panax* steam extract product, using Example 1 on pages 4-5 of the instant Specification as a guide. Further, the preamble should more clearly reflect the instantly disclosed method- e.g., --A method for preparing an oxygenated *Panax* extract-- or similar phraseology, as this would also help clarify the disclosed desired final extract product (since the term "oxygenated" means to treat or infuse with oxygen [Webster's Dictionary, 1988] and, thus, is clearly supported by the instant teachings). In addition, it is suggested that the final step in the claim 1 process correspondingly recite --to obtain an oxygenated *Panax* extract--.

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In addition, claim 1 recites the limitation "the oxygen-enriched atmosphere" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 is rendered vague and indefinite firstly because the ambiguous and unclear language of the claimed preparation process as instantly recited in claims 1-3 causes the product produced thereby to be ambiguous and unclear for the reasons set forth above and, secondly - as discussed above, the phrase "A processed *Panax* spp." does not adequately or properly define an extract product thereof (e.g., this would imply the whole plant as being the processed product vs. an extract of the plant). It is, therefore, suggested that the claim 4 recite --An oxygenated *Panax* extract obtained by the method according to ...--.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (US 5,776,460) in view of Ouyang et al. (CN 1200892 - DWPI Abstract).

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Although very unclear due the U.S.C. 112, second paragraph rejections above, a method of making *Panax* (such as *Panax ginseng*) via steaming the *Panax* under an oxygen-enriched atmosphere, as well as the product made thereby is apparently claimed.

Kim et al. teach preparing a *Panax ginseng* extract having various desired pharmaceutical effects including immune enhancement activity (see, e.g., col 1, lines 18-30) via steam extraction of the *Panax ginseng* (see entire document including Examples). Kim et al. do not teach using oxygen-enrichment during the steam extraction process.

Ouyang et al. teach preparing an oxygen-enriched ginseng-containing tea (including, e.g., from ginseng tassles - i.e., roots) which provides effective immune enhancement activity, whereby the liquid mixture decoction is subjected to high pressure oxygenation (oxygen enrichment) - see abstract.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include high pressure oxygenation (oxygen enrichment) during the steam extraction process taught by Kim et al. based upon the beneficial teachings provided by Ouyang et al. with respect to preparing a ginseng extract product having effective immune stimulating activity, which Kim et al. disclose is a desirable activity of such ginseng extracts.

Thus, the invention as a whole is *prima facie* obvious over the references, especially in the absence of evidence to the contrary.

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Conclusion

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (703) 305-7114. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached at (703) 306-3220. The Group receptionist may be reached at (703) 308-0196. The fax number for art unit 1654 is (703) 872-9306.

A handwritten signature in black ink, appearing to be 'C. Tate', with a large, stylized loop at the beginning.

Christopher R. Tate
Primary Examiner, Group 1654